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32192	7590	06/04/2008	EXAMINER	
BRADLEY N. RUBEN, PC 463 FIRST ST, SUITE 5A HOBOKEN, NJ 07030			SHEEHAN, JOHN P	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/528,305

## Applicant(s)

OH ET AL.

## Examiner

John P. Sheehan

## Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-12 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date 7/11/06 9/6/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I claims 1 to 7, 10 to 12 and 16 to 20 in the reply filed on March 5, 2008 is acknowledged.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

3. Figure 4, 9 and 32 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Each of Figures 4, 9 and 32 appear to be directed to the prior art.

I. Regarding Figure 4, see page 18 of the specification, the last paragraph.

II. Regarding Figure 9, see page 20 of the specification, lines 17 and 18.

III. Regarding Figure 32, see page 3 of the specification, the last 4 lines to page 4, line 12.

### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

I. The specification does not provide proper antecedent basis for the subject matter recited in claims 4 to 6 and 17 to 20.

### ***Claim Objections***

5. Claims 4, 5, 7 and 17 to 20 objected to because of the following informalities:

I. The Examiner objects to the phrase, "any one of", used in line 2 of each of claims 4, 5, 7 and 17 to 20. Each of these claims depends on a single preceding claim. Thus the use of the phrase, "any one of" is not appropriate.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 10 to 12 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The step of magnetizing the magnetic powder prior to critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

I. Throughout the specification it is disclosed that in the method of manufacturing a magnetic device the magnetic powder is magnetized prior to mixing the magnetic powder with the resin (for example, see the specification Example 2, Figure 1(a) and page 12, line 16 to page 13, line 9). However, claims 10 to 12 do not recite the step of magnetizing the magnetic powder prior to mixing the magnetic powder with the resin.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by anyone of Lyman (Lyman '588, US Patent No. 3,985,588, cited by the Examiner), Ozaki et al. (Ozaki '507, Japanese Patent Document No. 02-153507, cited in the IDS submitted September 6, 2006) or Ozaki et al. (Ozaki '047, Japanese Patent Document No. 6-244047, cited in the IDs submitted July 11, 2006).

Each of the references teaches a method of making a bond magnet comprising magnetizing a magnetic powder, mixing the pre-magnetized powder with a resin and applying a magnetic field to the magnetic powder-resin mixture while the resin is hardened (Lyman '588, column 3, lines 10 to 28; Ozaki '507, Abstract; and Ozaki '047, Abstract). The process recited in applicants' claim 1 encompasses the processes taught by each of the references.

10. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Lyman (Lyman '588, US Patent No. 3,985,588, cited by the Examiner).

Lyman '588 teaches and is applied as set forth above. Further, Lyman '588 teaches that the resins recited in claim 7 are known for use in making resin bonded magnetic powder magnets (column 5, lines 15 to 35). The process recited in applicants' claim 7 does not distinguish over the process taught by Lyman '588.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 and 10 to 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaru et al. (Masaru '906, Japanese Patent Document No. 4-3906) taken in view of Lyman (Lyman '588, US Patent No. 3,985,588, cited by the Examiner).

Masaru '906 teaches a method of making a bond magnet wherein a magnetic powder-resin mixture is positioned in a magnetic device and a magnetic field is applied to the magnetic powder-resin mixture while the resin is hardened (Abstract).

Lyman '588 teaches that a method of making a magnetic powder-resin bond magnet wherein the magnetic powder is magnetized prior to the mixing the magnetic powder with the resin (column 3, lines 10 to 28). Lyman '588 teaches that such a pre-magnetization step results in the optimum magnetization of the particles (column 2, lines 59 to 64).

The claims and Masaru '906 differ in that Masaru '906 does not teach pre-magnetizing the magnetic powder prior to mixing the magnetic powder with the resin.

However one of ordinary skill in the art at the time the invention was made would have been motivated to pre-magnetize the magnetic powder so as to obtain the optimum magnetization of the magnetic powder as taught by Lyman '588.

13. Claims 3 and 16 to 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaru '906 taken in view of Lyman '588 as applied to claims 2 and 10 to 12 above, and further in view of Kinya et al. (Kinya '503, Japanese Patent Document No. Kinya et al. (Kinya '503, Japanese Patent Document No. 2002-105503, cited in the IDs submitted July 11, 2006).

The combination of Masaru '906 taken in view of Lyman teaches and is applied as set forth above in the preceding paragraph.

Kinya '503 teaches adding a rust proofing layer to a magnetic powder so as to improve the corrosion resistance of the magnetic powder prior to the use of the magnetic powder in making a bonded magnet (Abstract, paragraphs 0015 and 0016 of the translation submitted by applicants). Kinya '503 teaches prior to mixing the magnetic powder with the resin, mixing the magnetic powder with a metal to obtain a mixture and heating the mixture to coat the surface of the magnetic powder (Abstract and paragraph 0023). Kinya '503 teaches specific examples of coating metals that are recited in applicants' claims (paragraph 0025).

The combination of Masaru '906 taken in view of Lyman do not teach the metal coating step recited in applicants' claim 3.

However one of ordinary skill in the art at the time the invention was made would have motivated to add the coating step taught by Kinya '503 to the combination of Masaru '906 taken in view of Lyman so as to improve the corrosion resistance of the magnetic powder as taught Kinya '503.

14. Claims 4 to 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyman '588 taken in vie of Ozaki '047..

Lyman '588 teaches a method of making a bond magnet comprising magnetizing a rare earth-cobalt (column 6, lines 1 to 10) magnetic powder, mixing the pre-magnetized rare earth-cobalt powder with a resin and applying a magnetic field to the rare earth-cobalt magnetic powder-resin mixture while the resin is hardened (Lyman '588, column 3, lines 10 to 28).



Ozaki '047 teaches that the rare earth magnetic powders recited in claims 4 to 6 are well known (Ozaki '047, the tables on the lower half of pages 285 and 287).

Lyman '588 and the claims differ in that Lyman '588 although teaching the use of rare earth-cobalt powder in general, does not teach the rare earth-cobalt magnetic powder recited in claims 4 to 6.

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because Lyman '588 teaches the use of rare earth-cobalt magnetic powder in general and one of ordinary skill in the art, with a reasonable expectation of success would, have been motivated to apply Lyman '588's process to any rare earth-cobalt magnetic powder such as those taught by Ozaki '047.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/  
Primary Examiner  
Art Unit 1793

Jps